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EXAMINER

MOLINARI, MICHAEL J

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 06/25/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,657

Applicant(s)

SPONAUGLE ET AL.

Examiner

Michael J Molinari

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-14, 16-19, 21-29 and 32-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu (U.S. Patent No. 6,275,575).
3. Referring to claim 1, Wu discloses a computer system comprising: a storage medium (Memory, see column 5, line 48) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror client, an electronic token representing an offer to participate in a voice call with a destination party designated by the offeror client (see column 5, lines 45-57), the electronic token to be transmitted by the offeror client in association with an electronic mail message to an offeree (see column 5, lines 45-57), services for receiving on behalf of the offeror client, through a data network link, a notification from the offeree denoting the offeree's acceptance of the offeror client's offer (see column 5, lines 57-63), and services for causing a voice call to be established between the destination party designated by the offeror client and the offeree in response to the offeree's acceptance of the offeror client's offer (see column 5, lines 66-67 and column 6, lines 1-3); and an execution unit coupled to the storage medium for executing the

Art Unit: 2665

plurality of programming instructions (Processors for executing instructions stored in memory are inherent in servers such as the one taught by Wu).

4. Referring to claim 2, Wu discloses that the offeree accepts the offeror client's offer by activating the electronic token displayed on the offeree's computer system (see column 9, lines 50-59).

5. Referring to claim 3, Wu discloses activating the electronic token comprises selecting the electronic token with a user input device (see column 9, lines 50-59).

6. Referring to claim 4, Wu discloses that the electronic token comprises a graphical icon (Softkey, see column 9, lines 50-59).

7. Referring to claim 6, Wu discloses that the voice call comprises at least one of a circuit switched call and a packet based call (see column 6, lines 5-6).

8. Referring to claim 7, Wu discloses that the services for causing the voice call to be established between the destination party designated by the offeror client and the offeree, comprise services for causing a first voice call to be established with the offeree, services for causing a second voice call to be established with the destination party designated by the offeror client, and services for causing the first and second voice calls to be bridged to place the offeree and the destination party designated by offeror client in voice communication with each other (see column 5, lines 64-67 and column 6, lines 1-9).

9. Referring to claim 8, Wu discloses that the destination party designated by the offeror client is the offeror client (see column 5, lines 45-67 and column 6, lines 1-9; the coordinator is the destination party).

Art Unit: 2665

10. Referring to claim 9, Wu discloses that the first and second voice calls each comprise a circuit switched call (see column 6, lines 5-6).
11. Referring to claim 10, Wu discloses that the first voice call comprises a circuit switched call and the second voice call comprises a packet based call.
12. Referring to claim 11, Wu discloses that the first voice call comprises a packet based call and the second voice call comprises a circuit switched call.
13. Referring to claim 12, Wu discloses that the first and second voice calls each comprise a packet based call.
14. Referring to claim 13, Wu discloses that the electronic token is generated on behalf of the offeror client based at least in part upon data provided to the computer system by the offeror client (see column 5, lines 45-57), the data associated with at least one of a PSTN extension corresponding to the destination party designated by the offeror client and a PSTN extension corresponding to the offeree (see Fig. 4A, which shows that the PSTN extension of the conference participants must be entered).
15. Referring to claim 14, Wu discloses that the PSTN extension corresponding to the offeror client is obscured to prevent the offeree from identifying the PSTN extension associated with the destination party designated by the offeror client (see Fig. 5B and note that the offer does not include the PSTN extension of the offeror client).
16. Referring to claim 16, Wu discloses a method comprising: transmitting by an offeror party in association with an electronic mail message, an electronic token representing an offer to participate in a voice call with a destination party (see column 5, lines 45-57 and see column 10, lines 18-22); receiving by an offeree party, the electronic token representing the offer to

Art Unit: 2665

participate in the voice call with the destination party (see Fig. 5B, which shows the communication device of the offeree with a display showing the offer); and bridging the voice call between the offeree party and the destination party, based at least in part upon the offeree party accepting the offer to participate in the voice call (see column 5, lines 66-67 and column 6, lines 1-6).

17. Referring to claim 17, Wu discloses that the offeree party accepts the offer to participate in the voice call by activating the electronic token representing the offer (see column 5, lines 57-67 and column 6, lines 1-4).

18. Referring to claim 18, Wu discloses that activating the electronic token includes selecting the electronic token with a user input device (see column 9, lines 50-59).

19. Referring to claim 19, Wu discloses that the electronic token comprises a graphical icon (Softkey, see column 9, lines 50-59).

20. Referring to claim 21, Wu discloses that the destination party is the offeror party (see column 5, lines 45-67 and column 6, lines 1-9; the coordinator is the destination party).

21. Referring to claim 22, Wu discloses that the voice call comprises at least one of a circuit switched call and a packet based call (see column 6, lines 5-6).

22. Referring to claim 23, Wu discloses that bridging the voice call further comprises: establishing a first PSTN call with the offeree; establishing a second PSTN call with the destination party; and bridging the first and the second PSTN calls (see column 5, lines 66-67 and column 6, lines 1-6).

Art Unit: 2665

23. Referring to claim 24, Wu discloses that bridging the voice call further comprises: establishing a first PSTN call with the offeree; establishing a second VOIP call with the destination party; and bridging the first PSTN call and the second VOIP call.

24. Referring to claim 25, Wu discloses that bridging the voice call further comprises: establishing a first VOIP call with the offeree; establishing a second PSTN call with the destination party; and bridging the first VOIP call and the second PSTN call.

25. Referring to claim 26, Wu discloses that bridging the voice call further comprises: establishing a first VOIP call with the offeree; establishing a second VOIP call with the destination party; and bridging the first and the second VOIP calls.

26. Referring to claim 27, Wu discloses that the electronic token is generated by a third party (Coordinating Server Device, see column 5, lines 45-57) based at least in part upon data provided to the third party by the offeror party in association with a contractual relationship previously established between the third party and the offeror party (see Fig. 4A, which shows information provided by the coordinator that is used to generate the electronic token).

27. Referring to claim 28, Wu discloses that the data provided to the third party by the offeror party includes a first PSTN extension corresponding to the offeree party and a second PSTN extension corresponding to the destination party (see Fig. 4A, which shows that the offeror party has provided telephone information for the offeree party (MEMBER #1) and the destination party (MEMBER #2)).

28. Referring to claim 29, Wu discloses that the second PSTN extension is obscured to prevent the offeree party from identifying the second PSTN extension (see Fig. 5B and note that the offer does not include the PSTN extensions of the attendees).

Art Unit: 2665

29. Referring to claim 32, Wu discloses a computer system comprising: a storage medium (Memory, see column 5, line 48) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for receiving on behalf of an offeror client, through a data network link, a notification from an offeree denoting the offeree's acceptance of the offeror client's offer to participate in a voice call with a designated destination party (see column 5, lines 57-63), the offer communicated to the offeree in association with an electronic mail message (see column 5, lines 45-57), and for causing the voice call to be established between the designated destination party and the offeree in response to the offeree's acceptance of the offeror client's offer (see column 5, lines 66-67 and column 6, lines 1-6); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (Processors for executing instructions stored in memory are inherent in servers such as the one taught by Wu).

30. Referring to claim 33, Wu discloses that the destination party is designated by the offeror (see Fig. 4A, where the offeror designated all of the participants, including the destination party).

31. Referring to claim 34, Wu discloses that the offeree party accepts the offer to participate in the voice call by activating the electronic token representing the offer (see column 9, lines 50-59).

32. Referring to claim 35, Wu discloses that the services for causing the voice call to be established between the designated destination party and the offeree, comprise services for causing a first voice call to be established with the offeree, for causing a second voice call to be established with the designated destination party, and for causing the first and second voice calls

Art Unit: 2665

to be bridged to place the offeree and the designated destination party in voice communication with each other (see column 5, lines 66-67 and column 6, lines 1-6).

33. Referring to claim 36, Wu discloses a computer system comprising: a storage medium (Memory, see column 5, line 48) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror client, an electronic token representing an offer to participate in a voice call with a designated destination party, the electronic token to be transmitted to an offeree in association with an electronic mail message (see column 5, lines 45-57); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (Processors for executing instructions stored in memory are inherent in servers such as the one taught by Wu).

34. Claims 1-2, 5, 7, 9-12, 16, 17, 20, 22, and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson (U.S. Patent No. 6,272,214).

35. Referring to claims 1-2 and 5, Johnsson discloses a computer system comprising: a storage medium having stored therein a plurality of programming instructions (see column 4, lines 22-26) to implement a set of communication services on the communication system for generating on behalf of an offeror client, an electronic token representing an offer to participate in a voice call with a destination party designated by the offeror client (see column 5, lines 15-20), the electronic token to be transmitted by the offeror client in association with an electronic mail message to an offeree (see column 5, lines 21-24), services for receiving on behalf of the offeror client, through a data network link, a notification from the offeree denoting the offeree's acceptance of the offeror client's offer (see column 5, lines 39-43), wherein the offeree accepts the offeror client's offer by activating the electronic token displayed on the offeree's computer

Art Unit: 2665

system (see column 5, lines 24-27), wherein the electronic token comprises a URL (see column 5, line 26), and services for causing a voice call to be established between the destination party designated by the offeror client and the offeree in response to the offeree's acceptance of the client's offer (see column 5, lines 27-38); and an execution unit coupled to the storage medium for executing the plurality of programming instructions (see column 4, lines 22-26).

36. Referring to claim 7, Jonsson discloses that the services for causing the voice call to be established between the destination party designated by the offeror client and the offeree, comprise services for causing a first voice call to be established with the offeree, services for causing a second voice call to be established with the destination party designated by the offeror client, and services for causing the first and second voice calls to be bridged to place the offeree and the destination party designated by offeror client in voice communication with each other (see column 4, lines 45-67 and column 5, lines 1-6 and 24-38).

37. Referring to claims 9-12, Jonsson discloses that each of the conference participants can participate via either a circuit switched call or a packet based call (see column 4, lines 41-44 and column 5, lines 34-38).

38. Referring to claims 16-17 and 20, Jonsson discloses a method comprising: transmitting by an offeror party in association with an electronic mail message, an electronic token representing an offer to participate in a voice call with a destination party (see column 5, lines 20-24); receiving by an offeree party, the electronic token representing the offer to participate in the voice call with the destination party (see column 5, lines 24-31); and bridging the voice call between the offeree party and the destination party, based at least in part upon the offeree party accepting the offer to participate in the voice call, wherein the offeree party accepts the offer to

Art Unit: 2665

participate in the voice call by activating the electronic token representing the offer and wherein the electronic token comprises a URL (see column 5, lines 24-38).

39. Referring to claims 22-26, Jonsson discloses that each of the conference participants can participate via either a circuit switched call or a packet based call (see column 4, lines 41-44 and column 5, lines 34-38).

Claim Rejections - 35 USC § 103

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

41. Claims 15 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S. Patent No. 6,275,575) as applied to claim 27 above, and further in view of DeSimone (U.S. Patent No. 6,175,619).

42. Referring to claim 15, Wu differ from claim 15 in that he fails to disclose programming instructions to implement services for receiving payment information from the offeror client in association with at least one of the first and second calls, and services for verifying the ability of the offeror client to pay an indicated amount, prior to causing the first and second voice calls to be bridged. However, providing billing information when setting up a conference call is old and well known in the art. For example, DeSimone teaches providing billing information when setting up a conference call (see column 2, lines 44-56), which has the advantage of enabling the provider of the service to collect fees for the service. One skilled in the art would have

Art Unit: 2665

recognized the advantage of providing billing information when setting up a conference call as taught by DeSimone. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate providing billing information when setting up a conference call as taught by DeSimone into the invention of Wu to achieve the advantage of enabling the provider of the service to receive payment for providing the service. Furthermore, the Examiner takes official notice that payment verification when using credit cards is old and well known in the art and has the advantage of saving the service provider money by preventing fraud. One skilled in the art would have recognized the advantage of payment verification. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate payment verification into the invention of Wu in view of DeSimone to achieve the advantage of saving the service provider money.

43. Referring to claim 30, Wu differs from claim 30 in that he fails to disclose that the coordinator of the conference provides billing information to the coordinating server when setting up the conference. However, providing billing information when setting up a conference call is old and well known in the art. For example, DeSimone teaches providing billing information when setting up a conference call (see column 2, lines 44-56), which has the advantage of enabling the provider of the service to collect fees for the service. One skilled in the art would have recognized the advantage of providing billing information when setting up a conference call as taught by DeSimone. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate providing billing information when setting up a conference call as taught by DeSimone into the invention of Wu to achieve the advantage of enabling the provider of the service to receive payment for providing the service.

Art Unit: 2665

44. Referring to claim 31, Wu differs from claim 31 in that he fails to disclose that the voice call is bridged only after payment verification is received by the third party from an independent party assuring that the offeror party will pay for the cost of the call. However, the Examiner takes official notice that payment verification when using credit cards is old and well known in the art and has the advantage of saving the service provider money by preventing fraud. One skilled in the art would have recognized the advantage of payment verification. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate payment verification into the invention of Wu in view of DeSimone to achieve the advantage of saving the service provider money.

Response to Arguments

45. Applicant's arguments filed 10 June 2003 have been fully considered but they are not persuasive.

46. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "when the offeree activates the electronic token, a voice call is established") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

47. Applicant has argued that, referring independent claims 1, 16, 32 and 36, Wu fails to teach that the voice call is established in response to the offeree's acceptance of the offeror client's offer. However, Wu teaches in column 5, lines 45-67 and column 6, lines 1-9 that the call is established in response to the offeree's acceptance of the offeror client's offer.

Art Unit: 2665

Specifically, the offeree responds and the server creates a script, which starts the call at a time that is selected by the offeree. Applicant has argued that Wu does not teach that the call begins immediately, however none of the rejected claims contains such a limitation.

48. Applicant has argued the independent claims, because they depend from claims 1, 16 or 32, should be allowed. However, as claims 1, 16 and 32 stand rejected and Applicant has not argued any of the dependent claims, all dependent claims also stand rejected.

49. Applicant has argued that Jonsson does not teach “services for causing a voice call to be established between the destination party designated by the offeror client and the offeree in response to the offeree’s acceptance of the offeror client’s offer”. It is clear in column 5, lines 7-52 that Jonsson teaches that a voice call is established between a destination party (the arranger) designated by the offeror client (the arranger) and the offeree (the invitee). Lines 39-52 show the details of how the call is connected. Applicant has specifically argued that the voice call is not established directly as a result of the offeree’s acceptance of the offeror client’s offer. However, it can be said that, in the teaching of Jonsson, that the offeree accepts the offer by calling the telephone number during the session (see column 5, lines 39-41). Clearly, then, the voice call is established in response to the telephone call made by the offeree.

50. Applicant has argued that claims 15 and 30-31, rejected by Wu in view of DeSimone, are allowable because of the “vast difference between Wu and the presently claimed invention”. However, as explained above, Wu does teach all of the claimed limitations and therefore the rejection of claims 15 and 30-31 is held to be valid.

Conclusion

Art Unit: 2665

51. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/694,657

Page 15

Art Unit: 2665

mjm

Michael Joseph Molihari

June 16, 2003



ALPUS H. HSU
PRIMARY EXAMINER